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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,571	01/07/2005	Jong Cheol Lim	DKC 1775	5945

7590 09/27/2007	
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EXAMINER
SZEKELY, PETER A

ART UNIT	PAPER NUMBER
1714	

MAIL DATE	DELIVERY MODE
09/27/2007	PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/520,571
Filing Date: January 07, 2005
Appellant(s): LIM ET AL.

**MAILED
SEP 27 2007
GROUP 1700**

Maria Parrish Tungol
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/3/07 appealing from the Office action mailed 8/14/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner, which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

U.S. Patent Application 10/489,545, filed 3/12/04 and U.S. Patent Application 10/520,842, filed 1/10/05.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-6 rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. The rejection of claims 1-6 under 35 U.S.C. 112, first paragraph as failing to comply with the enablement requirement is withdrawn by the examiner.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The enablement rejection of claims 1-6 is withdrawn by the examiner.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had

possession of the claimed invention. The deletion of the words "consisting of" broadens the scope of the claims beyond the original specification and thus constitutes new matter. (The specification has also been amended to delete the words "consisting of").

(10) Response to Argument

The original specification and claim 1 both restricted the monomer mixture (B-1.1) used for the graft copolymer component (B-1) to the ones listed in the paragraph overlapping pages 3 and 4 and pages 6 and 7 of the specification, by using the words "consisting of". The choice of the phosphorus compounds (D-1 and D-2) was restricted similarly in the paragraph overlapping pages 4 and 5. Applicants first changed the phrase "consisting of" to "comprising" and then in a later response deleted the word "comprising". Furthermore, later added claim 5 copies the language of amended claim 1. The specification has also been amended to delete the words "consisting of". The phrase "consisting of" has exactly the same meaning in the description and in the claims. It means that no other ingredient besides the ones listed can be present in the group described. This means that applicants had not been in possession of any other monomers or phosphorus compounds, which can be used and ingredients (B-1) or (D) besides the ones in the paragraphs mentioned above. The amended language permits the presence of other monomers, for example (meth)acrylic acid, vinyl acetate or cyclopentadiene or other phosphorus compounds for example phosphazenes or phosphites. The original description does not mention the possibility of using other monomers or phosphorus compounds besides the ones listed and the phrase "consisting of" forbids the use of any other monomer or phosphorus compound besides

the ones listed. Accordingly, the deletion of the phrase "consisting of" broadens the claims beyond the limitations of the original description and as such it clearly constitutes new matter. Since both the description and the claims are parts of the same specification, applicants' allegation that they mean different things in the description and the claims does not hold water. The presence of the phrase "consisting of" definitely teaches one of ordinary skill in the art, that the materials to be used are restricted to the ones mentioned afterward. It is the legal meaning of the phrase "consisting of" which counts, a patent application is a legal document. While applicants can be their own lexicographers, they cannot change the meaning of legal terms to suit their convenience. The amended claims are broader than the original specification, the expanded limits of (B-1) and (D) have no antecedent basis in the original specification. Whether the presence of the term "consisting of" was necessary or not is completely irrelevant. Its presence in itself is proof that the exclusion of other materials is critical. It says that no other materials can be used. Its absence changes the scope of the invention. As far as the alleged "error " in using the phrase "consisting of" is concerned, it is an unsupported assertion by an attorney, which cannot take the place of objective evidence. See *In re Pearson*, 181 USPQ 641, 646 (CCPA 1974). But even if there had been an error made transcribing the instant application from the original Korean application, said error cannot be corrected by a Preliminary Amendment. Neither the Preliminary Amendment nor the Oath says anything about any error.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Peter Szekely



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